

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Toro Company
v.
Buck Knives, Inc.

Opposition No. 96,756
to application Serial No. 74/415,642
filed on July 22, 1993

Linda M. Byrne of Merchant, Gould, Smith, Edell, Welter &
Schmidt, P.A. for opposer.

Lisa A. Sanderson, Esq. for applicant.

Before Sams, Rice, and Quinn, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An application has been filed by Buck Knives, Inc. to
register the mark GREENSMaster for multi-function utility
pocket knives.¹

Registration has been opposed by The Toro Company,
which asserts that applicant's GREENSMaster knives include
golf-related tools, e.g., a divot replacer and a cleat

removing tool; that since prior to applicant's claimed date of first use of its mark, opposer has marketed a variety of golf-related tools and machines, including mowers for golf course greens, under the mark GREENSMaster; ownership of a registration of the mark GREENS MASTER for turf care equipment, including lawn mowers;² and a likelihood of confusion. Opposer also alleges, as an additional ground for opposition, that applicant's mark is not in "use" as defined by §45 of the Trademark Act of 1946, 15 U.S.C. §1127, i.e., that the mark is not "placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto."

Applicant, in its answer to the notice of opposition, admits that its GREENSMaster knives include golf-related tools, e.g., a divot replacer and a cleat removing tool; denies that these are the only tools contained in the knife; and denies opposer's remaining salient allegations.³

¹ Application Serial No. 74/415,642 filed on July 22, 1993, claiming first use and first use in commerce in March 1993.

² Registration No. 844,506 issued February 20, 1968 and renewed; Sec. 8 affidavit accepted; Sec. 15 affidavit received.

Opposer pleaded ownership of a second registration, namely, Registration No. 1,040,435 issued June 1, 1976 for the mark GREENSMaster 3 for turf care equipment, namely, lawn mowers, spikers, thatchers, groomers, and debris removers. During its testimony period, opposer made of record a status and title copy of the registration showing that it was then subsisting and owned by opposer. However, the records of the Patent and Trademark Office reveal that the registration expired shortly thereafter. Accordingly, we have given it no consideration herein.

³ Applicant pleaded the affirmative defense of laches. Aside from the fact that applicant offered no evidence in support of this defense, the pleading thereof is legally insufficient as a

The record consists of the pleadings; the file of the opposed application; a status and title copy of opposer's pleaded registration of the mark GREENS MASTER, applicant's responses to opposer's requests for admissions numbers 1, 5, 7, 8, 10, 13, 18, 19, 20, 23, 25, 27, and 28, opposer's requests for admissions numbers 31-51 (all of which stand admitted because applicant failed to respond to them), and applicant's responses to opposer's interrogatories numbers 3-7, 9-10, 12, and 21-23, all made of record by opposer by notice of reliance;⁴ and the testimony depositions, with exhibits, of opposer's witnesses R. Lawrence Buckley and

matter of law for a proceeding such as this, because it asserts delay by opposer in objecting to applicant's use of its mark, not delay in objecting to applicant's registration thereof. See, in this regard, *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991), and *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401 (11th Cir. 1991). Accordingly, we will make no further mention of applicant's asserted defense.

⁴ Opposer also included in its notice of reliance the affidavit of Ms. Julie K. Holthus, a legal assistant for opposer, concerning her purchase of one of applicant's golfer knives. Attached as exhibits to the affidavit were a photograph of the knife and its box, and photocopies of the package insert and of the flattened out box. The affidavit and exhibits were offered in an attempt to prove that applicant does not use the mark GREENSMaster on the knife or the box or package insert therefor. Trademark Rule 2.123(b), 37 CFR §2.123(b), provides, in relevant part, that *by agreement of the parties*, the testimony of any witness of any party may be submitted in the form of an affidavit by such witness. Here, there is nothing in the record to show that applicant agreed to the submission of the testimony of Ms. Holthus in affidavit form. Moreover, the fact that Ms. Holthus may have purchased one golfer knife made by applicant that does not bear the mark does not necessarily mean that applicant did not sell other such knives which did bear the mark in some manner.

Helmut J. Ullrich. Only opposer has filed a brief on the case. Neither party requested an oral hearing.

Opposer's evidence shows that since at least as early as 1974 (the year when opposer's witness Helmut J. Ullrich began working for opposer), opposer has continuously and prominently used the mark GREENSMaster in connection with greens mowers, i.e., mowers for golf course greens, and parts and accessories therefor. All of opposer's greens mowers, which include both riding greens mowers and walking greens mowers, are sold under this mark. The mark is used on the mowers themselves, as well as on invoices, owner's manuals, catalogs, product brochures, etc. therefor. GREENSMaster greens mowers are sold, by opposer's commercial division, primarily to golf courses (where they are purchased by golf course superintendents and used by maintenance personnel), but also to municipalities (that own golf courses), to landscape contractors who maintain golf courses, and occasionally, in the case of the walking greens mowers, to homeowners. Opposer sells its greens mowers to exclusive distributors who in turn sell them to the end users throughout the United States.

Opposer promotes its GREENSMaster greens mowers in various ways, including direct mailers; product brochures and flyers; promotional videos; exhibits at trade shows, namely, the International Golf Course Superintendents Show

of America and state regional shows; and advertisements in trade magazines such as Golf Course Management, Golf News, Southern Golf, Grounds Maintenance, and Landscape Management. Opposer's annual advertising expenditures and sales figures for its GREENSMaster mowers are quite substantial.⁵ Indeed, opposer, with its GREENSMaster riding greens mowers, is the market share leader in the riding greens mower industry, having more than half the market share for such mowers. The GREENSMaster mark is one of opposer's most important marks, and there is no doubt that the mark is very well known in the field.

The record also shows, inter alia, that opposer has policed its GREENSMaster mark rigorously and successfully with respect to golf-related products and services; that opposer's consumer division sells lawn mowers (albeit not under the GREENSMaster mark) to homeowners; that these lawn mowers are sold through hardware stores and mass merchandisers of consumer products; that these sorts of stores also sell pocket knives; that opposer has sold and given away (including to golf course superintendents) multi-function pocket knives bearing its house mark TORO as promotional items; that golfers typically carry tools for repairing ball marks on golf greens; that a divot repair

⁵ Opposer's sales and advertising figures for its GREENSMaster mowers were made of record as confidential material, filed under seal.

tool would be used for repair of damage to the green typically caused by golf balls striking the green and creating dents or scars that would impair the ability of the ball to roll evenly over the green; that a cleat wrench is used to tighten loosened cleats on golf shoes; that greens mowers are mowers which are designed to cut very precisely, at a consistent height of cut, because the trueness of ball roll is influenced by how uniformly the green is cut; and that golfers see opposer's GREENSMaster mowers in use on the golf course.

Opposer's discovery efforts reveal that applicant has used the mark GREENSMaster only in connection with a multi-function utility pocket knife which contains a variety of implements. The implements on the knife include a cleat wrench and a divot repair tool, both of which are tools useful to golfers. According to applicant's answer to opposer's interrogatory No. 6, the GREENSMaster knife was first sold by applicant in intrastate and interstate commerce in January 1993.⁶ The mark does not appear on the goods themselves or on package inserts therefor. However, applicant states in its answer to opposer's interrogatory No. 6 that it uses the mark on UPC labels appearing on boxes

⁶ Applicant's application specifies March 1993 as the date of first use, and first use in commerce, of applicant's mark. It is of no moment whether applicant first used its mark in January or in March of 1993, however, because there is no question as to opposer's priority.

and clam packs containing the knives,⁷ as well as in its dealer catalog, consumer direct catalog, price list, promotional brochures, and print advertising.

Applicant sells its GREENSMaster knife directly to mass merchants, dealers, distributors, warehouse clubs, and catalogs. The knife is also sold through the use of independent sales representatives to a variety of sporting goods stores, cutlery stores, gift stores, and drug stores, and by direct mail catalog. Opposer's testimony indicates that pocket knives may also be sold in golf pro shops. The primary customers for the knife are golfers or people buying the knife for golfers.

Applicant has promoted its GREENSMaster knife through exhibits at "a variety" of trade shows (applicant's answer to opposer's interrogatory No. 12(d), and through advertisements in magazines such as Audubon, Summit, Canoe, National Parks, Outside, Sierra, and Backpacker. In addition, a news photo and product description featuring the GREENSMaster knife was sent by applicant on February 10, 1993 to more than 20 consumer and trade golf magazines, including some of the golf magazines in which opposer advertises its GREENSMaster mowers. Applicant's total advertising expenditures for its GREENSMaster knife for the period 1993-1995 amounted to a little more than \$135,000.

⁷ As discussed more fully hereafter, the record does not include

Sales of the knife for the same period amounted to more than \$120,000.

Opposer's discovery efforts also reveal, via its requests for admissions, that a divot repair tool can be used to repair turf on a golf green; that it helps to smooth out the surface of a golf course green; and that applicant promotes the GREENSMaster knife as being for golfers. For example, the knife is described in applicant's 1995 direct mail catalog as "a golfer's dream knife-tool." Another of applicant's 1995 catalogs includes, under the mark "GreensMaster", the wording, "Every golfer will want this versatile SwissBuck in his bag. It has a divot replacer and a cleat removing tool, ..." ⁸ One of applicant's brochures describes the knife as "For golfers; includes cleat wrench and divot repair tool", while another brochure describes it as "Golfer's friend! Divot repair tool, cleat wrench ..." In the news photo and product description forwarded by applicant to a number of golf magazines on February 10, 1993, the headline reads, "NEW SWISSBUCK GREENSMaster, HANDY GOLFER'S KNIFE", and the product description text begins as follows:

"GreensMaster," newest addition to the growing line of SwissBuck knife-tools, has been designed to provide golfers with a versatile companion on the course. One of its 10 elements is a special

any examples of use in this manner.

⁸ SWISSBUCK is a mark used by applicant to identify a line of knives, one of which is the GREENSMaster knife.

tool for repairing divots and ball marks on the green; another is a cleat wrench. ...

Finally, an advertisement which was published in several magazines included a picture of the knife along with the wording "New GreensMaster Golfer's Knife" in large letters and then, in smaller letters, the wording "Includes a cleat wrench and a tool to repair ball marks".

We turn first to opposer's asserted ground that applicant's mark is not in use in commerce in a trademark sense as defined in §45 of the Act, i.e., that it is not placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto. We find that opposer has failed to prove, by a preponderance of the evidence, that such is the case. In this regard, applicant admitted, in its responses to opposer's requests for admissions Nos. 8 and 10, that applicant's GREENSMaster mark does not appear on the GREENSMaster product or on the package insert sheet therefor. Applicant's answers to opposer's interrogatories 6 and 7 indicate that the mark is used instead on UPC labels on boxes and clam packs containing the goods, and that such use has been made since January of 1993, a date prior to the filing of the application.⁹

⁹ Applicant's 1995 direct mail catalog for consumers was made of record through opposer's request for admission No. 33. The catalog includes a picture of applicant's golfer pocket knife, the mark "GREENSMaster™" in large capital letters immediately

Applicant failed to respond to, and thus admitted, opposer's request for admission No. 51, which asked applicant to admit that Exhibit 0 (attached to the request for admission) is a true and correct copy of a box and UPC label of the type used for packaging applicant's GREENSMaster product. Exhibit 0 is a photocopy of two sides of a four-sided box, with the UPC label appearing on one of the two visible sides. The mark GREENSMaster does not appear on either the UPC label or on what can be seen of the box. However, the other two sides of the box, including their end flaps, are not visible in the photograph. This is significant, because the specimens of record in applicant's opposed application are boxes for the goods. The mark GREENSMaster appears, along with the product model number and catalog number, on a small label (which does not, however, appear to be a UPC label)¹⁰ on one of the end flaps

thereunder, the model number and then a description of the product in much smaller printing thereunder, followed by a catalog number, the price, and ordering information. This is clearly trademark use of a type which can serve as a basis for registration. See *Lands' End Inc. v. Manbeck*, 24 USPQ2d 1314 (E.D. Va. 1992). However, applicant's answer to opposer's interrogatory 7 indicates that this type of use did not commence until after the filing of applicant's application, and that the only use of the mark made by applicant prior to the application filing date was the use on UPC labels and some use in advertisements, the latter of which was discontinued in 1995.

¹⁰ In *The Random House Dictionary of the English Language* (Second Edition Unabridged, 1987), the listing for the designation "UPC" reads, "[S]ee **Universal Product Code**." The definition for "Universal Product Code" reads, "a bar code that indicates price, product classification, etc., and can be read electronically, as at checkout counters in supermarkets. *Abbr.*: UPC". The boxes submitted by applicant as specimens have on their sides a fairly

of the box.¹¹ For all we know, and for all applicant might have known when it failed to respond to opposer's request for admission No. 51, and thus admitted the same, the small label bearing the mark may be affixed to one of the end flaps which is not visible in the photograph; and applicant may have mistakenly referred to the label which bears the mark as a UPC label.¹² Even if the box pictured in Exhibit O does not bear the mark GREENSMaster anywhere, including on any label affixed thereto, that does not necessarily mean that applicant has not also sold its multi-function utility pocket knives in boxes which do bear the mark on an end flap label.¹³ In short, opposer had the burden of proving, by a preponderance of the evidence, that applicant made no

large label with a bar code as well as certain print matter (not including the mark GREENSMaster). This is clearly a UPC label. The small label appearing on the end flap and bearing the mark GREENSMaster has no bar code. Therefore, it does not fit the definition of a UPC label.

¹¹ Of course, the specimens of record are not evidence in applicant's behalf herein because they have not been identified and introduced in evidence as exhibits during the time for taking testimony. See Trademark Rule 2.122(b)(2), 37 CFR §2.122(b)(2).

¹² Opposer itself, in its brief on the case, refers to the small label on the specimen box as "a small UPC label."

¹³ We cannot agree with opposer's argument that the use of applicant's mark on the "small UPC label" is too small to constitute prominent, acceptable trademark use. Applicant's mark GREENSMaster is used in small letters on a small label. Nevertheless, when it is noticed, it clearly creates the impression of a trademark. As stated by the Court of Customs and Patent Appeals, in In re Singer Manufacturing Co., 255 F.2d 939, 118 USPQ 310, 312 (1958):

No authority is cited, and none has been found, to the effect that trademark use requires a display of a design of any particular size or degree of prominence. The important question is not how readily the mark will be noticed, but whether, when it is noticed, it will be understood as indicating origin of

trademark use of its mark, within the meaning of §45 of the Act, prior to the filing date of its application. Opposer's evidence does no more than raise a question as to whether such use was made prior to the filing date. This is manifestly insufficient to meet opposer's burden of proof.

This brings us to the Section 2(d) ground. It is clear from the record that opposer not only owns a registration of the mark GREENS MASTER for turf care equipment, including lawn mowers, but also has used the mark GREENSMaster to identify its greens mowers since long prior to applicant's date of first use. Moreover, applicant's mark GREENSMaster is identical to opposer's previously used mark GREENSMaster and is substantially identical to opposer's registered mark GREENS MASTER.

Thus, the only issue remaining to be resolved is whether the contemporaneous use of the mark GREENSMaster in connection with applicant's multi-function utility pocket knives and opposer's greens mowers is likely to cause confusion, or to cause mistake, or to deceive. The evidence of record, as detailed above, shows, inter alia, that applicant's GREENSMaster multi-function utility pocket knife contains tools useful to golfers; can be used to repair turf on a golf green; is promoted as being for golfers; and is purchased primarily by golfers or by people buying the knife

for golfers. Moreover, the record indicates that golfers see opposer's GREENSMaster mowers in use on the golf course; that applicant has sent a press release concerning its product to magazines which carry advertisements for opposer's mowers; that pocket knives may be sold in golf pro shops; and that opposer itself has sold and given away (including to golf course superintendents) multi-function pocket knives bearing its house mark TORO as promotional items. Considering these factors, together with the lack of evidence of third-party use of similar marks in the golf field, and the fact that opposer's mark is very well known in that field, we are persuaded that there is, in this case, a likelihood of confusion. Indeed, applicant has offered no evidence or argument to the contrary. If we had any doubt on the issue of likelihood of confusion, which we do not, that doubt would have to be resolved in favor of opposer, the registrant and long-prior user. *See, for example, J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991), and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The opposition is sustained, and
registration to applicant is refused.

J. D. Sams

J. E. Rice

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board